

The specification has been amended to conform to the amendments to the claims.

Reconsideration of the rejection of claims 1-20 under 35USC103(a) as being unpatentable over Griffiths taken in combination with Jonat is respectfully requested in view of the amendment to claim 1 and the following comments.

The Griffiths patent specifically teaches that the sponge is located in a pocket located in the heel of the footwear and that the noise-maker 3 is located at a point removed from the back or rear of the footwear. As shown and described the noise-maker 3 is located on the side of the footwear adjacent the arch of the footwear.

The Jonet patent specifically teaches that the noise-maker 26 is located in cavity 22 in the toe of the footwear. See column 2, lines 44-57 of this patent wherein it is stated that cavity 22 covers only the toe portion of the sole of the footwear 10.

Neither of the Griffiths or Jonet patents teach or even remotely suggest that the noise-maker of Griffiths could be placed in the majority of the sole of the footwear remote from the heel. This statement by the Examiner could only be prompted by the teachings of the application, not the teachings of the cited references.

Further, neither of the cited references even remotely suggest that the spongy material is disposed over a majority of the sole remote from the heel/^{and} that a passageway is disposed in the sole between the spongy material and an exterior of the heel at the back of the footwear. This specific structure recited in amended claim 1 is not shown or even remotely suggested by the cited patents to Griffiths and Jonet taken singly or in a valid combination. Because of these specific structural limitations found in amended claim 1, claims 2-20 depending therefrom are also patentable over the cited references and the other references of record.

As pointed out hereinabove, the noise-maker 3 of Griffiths is at the side of the footwear, not at the back of the footwear and no passageway as spelled out in amended claim 1 is found or taught in Griffiths.

With regard to Jonet, the noise-maker 26 is in cavity 22 and recess 24. There is no passageway found in the teachings of this reference as set forth in amended claim 1. There is no teachings in Jonet that the noise-maker 26 has any connection to the atmosphere which is required in Applicant's arrangement and also in Griffiths arrangement.

With regard to claims 5,11,15 and 18, specific structure for

Applicant's noise-maker to provide a one-way air noise-maker is setforth which is not shown in the cited references or the other references of record. This structure is important to Applicant's arrangement, since one-way noise-makers are better than two-way noise-makers. Only one noise, or beep, is made for each step with a one-way noise-maker, rather than the two beeps per step provided by a two-way noise-maker which can be confusing to a youngster. Also, the structure setforth in these claims is the preferred structure found by the Applicant to be easier to manufacture.

The Examiner has made a broad statement that any one-way noise-maker would be obvious without citing art to show that it is obvious. Such broad obvious statements should be backed up by prior art to support such a statement. The structure setforth in claims 5,11,15 and 18 is the structure Applicant prefers for his one-way noise-maker due to its simplicity and ease of manufacture. Applicant should not be deprived of patent protection for this specific structure just because Examiner feels it is obvious and that there are other one-way noise-makers that could be employed. This is true and is covered by the broad language of claims 1,4, 10 and 14. Just because other one-way noise-makers could be employed in the heel of Applicant's arrangement does not render Applicant's preferred structure of claims 5,11,15 and 18, which is not shown in any of the references of record and, in particular, the cited references, obvious.

It should be kept in mind that the noise-maker of Applicant's arrangement is part of the solid heel and helps the footwear stay firm without distorting its shape or comfort. Griffiths has his noise-maker built into the air-pocket which could cause injury to a child or adult having delicate feet. Also, Griffiths' arrangement is a footwear in-sole which can be removed from footwear which can compromise the comfort of the footwear. In Applicant's arrangement the sole is an integral part of the footwear and can not be separated from the footwear and, therefore, the inside of the footwear is not distorted or misaligned during assembly resulting in no discomfort during walking.

The Examiner is reminded that the references must suggest the combination and resulting modification, not the application. The Examiner's attention is directed to the Sixth Edition, Revision #2 of the MPEP, Section 706.02(j) (Pages 700-16 and 700-17) and the court decisions cited therein at the end of the second paragraph of Page 700-16 and at the end of the paragraph bridging pages 700-16 and 700-17. The restrictions set down in these court cases on combining references should be kept in mind and followed exactly when rejecting claims on a combination of references under 35USC103.

If the Examiner disagrees with the language used in the amendments to the claims and specification, the undersigned would appreciate a telephone interview with the Examiner if he would like the wording of the claims and specification employing the Examiner's language to be present to place the claims in condition for allowance.

In view of the foregoing, it is respectfully submitted that amended claims 1-20 overcome the rejection under 35 USC112, second paragraph, and patentably distinguish over the cited references and the other references of record because of the structural limitations contained therein. Therefore, allowance of amended claims 1-20 and the passing of the application to issue is respectfully solicited.

Respectfully submitted,



Alfred C. Hill
Agent for Applicant
Reg.No. 17,897

ACH/ach
Date; November 18, 1996
9 Shirley Terrace
Kinnelon, NJ 07405
Tele/FAX No. (201)838-2731